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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/773,503 | 02/06/2004 | Michael E. McClurken | 13045.20USC1 | 6627 |
| 23552 7590 06/21/2007 MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903 | | | EXAMINER PEFFLEY, MICHAEL F | |
| | | | ART UNIT 3739 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/773,503

Applicant(s)

MCCLURKEN, MICHAEL E.

Examiner

Michael Peffley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-65 is/are pending in the application.
- 4a) Of the above claim(s) 52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-51 and 53-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/6/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Applicant's amendments and comments, received December 15, 2006, have been fully considered by the examiner now of record. New art has been found that is deemed to read on rewritten claims 63-65 (previously indicated as allowable by the previous examiner). As such, the instant Office action is non-final.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 37-51 and 53-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Eggers et al (6,032,674).

Eggers et al disclose a probe that includes an end-effector (i.e. distal end) that may simultaneously provide RF energy via one or more electrodes (270) and fluid (2783 to tissue (see Figure 18). Eggers et al also disclose a dimensional change sensor (310) which is an ultrasound sensor that detects a change in the thickness of tissue as it is being ablated. The sensor is used to control the output of RF energy and alerts the user of changing tissue thickness to prevent creating too deep a channel in tissue (col. 23, lines 50-63). The examiner maintains the device is inherently a "shrinkage sensor" since the channel created by the device is creating a shrinking tissue area (i.e. channel) that is being detected by the sensor, and the sensor provides feedback regarding the shrinking of the tissue (i.e. the depth of the channel).

Eggers et al disclose various arrangements for the electrodes, and the device may be operated in either a monopolar or a bipolar manner. Eggers et al also provide for multiple fluid lumens (figure 2a).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 63-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bommannan et al (6,775,575) in view of the teaching of Mulier et al (6,096,037).

The Bommannan et al device comprises an end effector (i.e. forceps jaws) that includes electrodes for treating tissue (see Abstract). Bommannan et al further disclose providing the jaws with sensors (250) for sensing the dimensional change of tissue (e.g. tissue thickness) and controlling the delivery of energy (see col. 5, line 64 through col. 6, line 34). The only feature not expressly taught by Bommannan et al is the provision of a fluid outlet to provide fluid during treatment.

Mulier et al disclose an analogous device for clamping and treating electrodes, and specifically teach that providing an electrolytic solution from fluid outlets in the jaws will enhance the delivery of energy to tissue.

To have provided the Bommannan et al device with a fluid source and fluid outlet to provide fluid to tissue to enhance the delivery of RF energy to tissue would have

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been an obvious modification for one of ordinary skill in the art in view of the teaching of Mulier et al.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 37-51 and 53-65 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-68 of U.S. Patent No. 6689131. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is clear that all the elements of claims 37-65 are to be found in claims 1-68. The difference between the claims of the instant application and claims 1-68 of the patent lies in the fact that the patent claim includes many more elements and is thus much more specific. Thus the invention of claims 1-68 of the patent is in effect a "species" of the "generic" invention of the application claims 37-65. It

has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

Response to Arguments

Applicant's arguments with respect to claims 37-51 and 53-58 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Negus et al (5,893,848), Ingle et al (6,216,704) and Pless et al (6,645,202) all disclose devices that include tissue thickness sensors, and Schechter et al (2004/0143263) discloses a forceps device with a thickness sensor.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Peffley/
Primary Examiner
Art Unit 3739

/mp/
June 13, 2007